

## REMARKS

### I. INTRODUCTION

Claims 1 to 10 are now pending after the addition of new claim 10. The amendment does not add new matter and finds support throughout the specification.

With respect to paragraph one (1) of the Office Action, the Examiner asserts that the declaration is defective and requires a new declaration.

With respect to paragraph three (3) of the Office Action, the Examiner asserts that the title is not descriptive, and the Examiner requests a new title that clearly indicates the invention. Applicants tender a new title, "METHOD AND DEVICE FOR CONTROLLING VEHICLE SPEED DURING DESCENT," in response to the Examiner's request.

With respect to paragraph four (4) of the Office Action, the Examiner rejected claims 1, 2, and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,594,735 to Sigl (Sigl).

Applicants thank the Examiner for indicating that claims 3 to 7 and 9 contain allowable subject matter and that these claims would be allowable if rewritten in independent form. Applicants respectfully request reconsideration of the present application.

### II. THE REQUIREMENT OF A NEW DECLARATION SHOULD BE WITHDRAWN

The Office Action objects to the declaration as not indicating who is the first and second inventor. However, contrary to the Examiner's assertion, there is no requirement that an oath or declaration identify which inventor is the "first" or "second" inventor. In fact, both inventors are first (and joint) inventors. The regulations embodied in 37 C.F.R. 1.63 are explicit with respect to the requirements of the declaration, stating only that:

- (a) An oath or declaration ...;
- (2) Identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial;
- (3) Identify the country of citizenship of each inventor; and
- (4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
- (c) Unless such information is supplied on an application data sheet ... the oath or declaration must also identify:

(1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor ....

Clause (a)(4) indicates clearly that *each* person executing the oath or declaration is a *first* inventor. Therefore, both inventors listed in the declaration are first inventors. The Examiner's requirement is without basis in the regulations and contrary to the explicit requirements of 37 C.F.R. 1.63(a)(4). The filed declaration satisfies the requirements of 37 C.F.R. 1.63, and therefore no supplemental declaration is necessary.

### **III. THE 35 U.S.C. § 102(b) REJECTION SHOULD BE WITHDRAWN**

The Examiner has rejected claims 1, 2, and 8 under 35 U.S.C. § 102(b) as anticipated by Sigl. To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim limitation is identically disclosed in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). “The identical invention must be shown in as complete detail as is contained in the claim.” (M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989)).

The rejection of independent claim 1 should be withdrawn because Sigl does not disclose each and every claim limitation of claim 1 identically. Claim 1 recites “[a] method for controlling a vehicle comprising . . . *detecting whether the vehicle is traveling on a descent.*” The Sigl reference simply does not detect whether the vehicle is traveling on a descent. The sections of Sigl cited in the Office Action as anticipating detection of a descent instead merely indicate that “it is only in a few operating states, *such as* when driving on downhill grades, that the adjusted speed is exceeded.” (Col. 3, lines 21 to 23; emphasis added). The Sigl reference merely lists a downhill grade as an *example* of a situation in which the adjusted speed is exceeded. The cited sections of the Sigl reference do not describe, nor even suggest, *detecting* a descent. Therefore, the Sigl reference cannot anticipate claim 1 of the present invention in which *a descent is detected* as part of the method.

This conclusion is particularly inescapable in light of the additional feature of the present invention of “calculating at least one manipulated variable based on the actual speed and the setpoint speed *only when the vehicle is detected as traveling on the descent,*” as recited in claim 1. There is no teaching in Sigl with respect to calculating a manipulated variable *only* when a descent is detected. In fact, as noted above, there is no provision in Sigl with respect to detecting a descent, and so it is impossible for the Sigl reference to anticipate calculating a variable *only* when a descent is detected. Therefore, the Sigl reference does not identically disclose the features of the present invention in as complete detail as is contained in claim 1, and therefore the reference does not anticipate the subject matter of claim 1.

Accordingly, it is respectfully submitted that Sigl cannot and does not anticipate claim 1 for the foregoing reasons, and it is therefore respectfully submitted that claim 1 is allowable.

Claim 2 depends from claim 1, and therefore is allowable for at least the same reasons as claim 1 is allowable. Additionally, dependent claims 3 to 7, though allowable if amended to include the features of their base claim, are also allowable in their present form.

With respect to claim 8, Sigl does not identically disclose all of the limitations of claim 8, and therefore does not anticipate claim 8 under 35 U.S.C. § 102(b). Claim 8 recites:

an output arrangement via which a manipulated variable that influences the actual speed of the vehicle is output based on the actual speed and the setpoint speed in order to influence the actual speed of the vehicle, wherein: the control device includes an enabling arrangement for enabling only the manipulated variable to be calculated and output, respectively, *if a descent of the vehicle has been detected.*

As noted above with respect to a comparable feature of claim 1, the Sigl reference does not disclose or suggest the feature of “enabling only the manipulated variable to be calculated and output, respectively, *if a descent of the vehicle has been detected,*” as recited in claim 8. The cited sections of the Sigl reference do not teach sensing a descent situation, and therefore Sigl cannot teach *calculating and outputting the manipulated variable only if a descent of the vehicle is detected.* Since the Sigl reference does not identically disclose all of the limitations of claim 8, it is respectfully submitted that the Sigl reference does not anticipate the subject matter of claim 8.

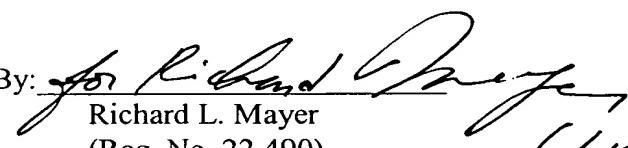
Accordingly, it is respectfully submitted that the Sigl reference cannot and does not anticipate claim 8 for the foregoing reasons, and it is therefore respectfully submitted that claim 8 is allowable. Additionally, dependent claim 9, though allowable if amended to include the features of claim 8, is also allowable in its present form. New claim 10 depends from claim 8, and therefore is allowable for at least the same reasons as claim 8 is allowable.

**IV. CONCLUSION**

In view of all of the above, it is believed that the rejections of claims 1, 2, and 8 have been obviated, and that all of claims 1 to 10 are allowable. It is therefore respectfully requested that the rejections be withdrawn and that the present application issue as early as possible.

Respectfully Submitted,  
KENYON & KENYON

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**AMENDMENT VERSION WITH MARKINGS**

**IN THE TITLE:**

Please replace the title with the following:

-- METHOD AND DEVICE FOR CONTROLLING VEHICLE SPEED

**DURING DESCENT --**